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Timothy A. Long
Chernoff, Vilhauer, McClung and Stenzel, L.L.P.
1600 ODS Tower
601 SW Second Ave.
Portland, OR 97204

EXAMINER

PHAM, KHANH B

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/882,416
Filing Date: June 15, 2001
Appellant(s): BEEK ET AL.

MAILED

SEP 06 2007

Technology Center 2100

Kurt Rohlf
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/10/2007 appealing from the Office action mailed 2/7/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

- "JPEG 2000 Image Coding System", Final Committee Draft Version 1.0, March 16, 2000
- Pereira, MPEG-7: a Standard for Describing Audiovisual Information", 1999
- MPEG-7 Multimedia Description Scheme, Description Definition Language V3.0, N3391.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-31, 33-42, 44-59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-31, 33-42, 44-59 direct to "a digital file stored on a computer readable medium"; however, the claimed "digital file" contains only non-functional descriptive material.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material". In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronic Terms 308 (5th ed. 1993).).

"Nonfunctional descriptive material" includes, but is not limited to music, literary works, **photographs** and compilation or **mere arrangement of data**. Both type of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F. 3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claims 1-59 are directed to nonfunctional descriptive material per se and therefore nonstatutory.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. **Claims 47-49 and 54 are rejected under 35 U.S.C. 102(a)** as being anticipated by "JPEG 2000 Image Coding System" Final Committee Draft Version 1.0, March 16, 2000, (supplied by Applicant in IDS, paper No. 6), hereinafter "IT-JPEG2000".

As per claim 47, IP-JPEG2000 teaches a digital file stored on a computer readable medium (see page 139, Fig. I-1), said digital file comprising:

- "a plurality of boxes containing data arranged in a manner consistent with the JPEG2000 specification and suitable to render an image" at page 139, Fig. I-1;
- "at least one of said boxes being a UUID box" at page 139, Fig. I-1, page 140, section I.4.5 and page 158, section 1.9.2;
- "including information within said UUID box indicating the location of binary data, within said file and not within said UUID box, associated with said image" at page 158, sections I.9.2 and I.9.3.

(IT-JPEG2000 teaches that UUID boxes can be used to store binary data, and UUID Info boxes, which act as index for the UUID's in the file, contains a list of UUID's and specifies links (i.e., "location") to more information. UUID boxes and UUID Info boxes are distinct but within the JPEG2000 file.)

As per claim 48, IP-JPEG2000 teaches the digital file of claim 47 wherein "said information is in XML format" at page 157, section I.9.1.

As per claim 49, IP-JPEG2000 teaches the digital file of claim 47 wherein "said digital file is compliant with the JPEG2000 standard" at page 140, section I.4.6.

As per claim 54, IT-JPEG2000 teaches the digital file of claim 47 wherein "said information includes links to information external to said digital file" at page 159, section I.9.3.2.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 41-42 and 44-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pereira** ("MPEG-7: a Standard for Describing Audiovisual Information", 1999), hereinafter "**Pereira**", and in view of "MPEG-7 Multimedia Description Scheme, Description Definition language V 3.0, N3391", (supplied by Applicant in IDS, paper No. 6), hereinafter referred to as "**N3391**".

As per claim 41, Pereira teaches a digital file stored on a computer readable medium (page 6/4, 3rd paragraph), said digital file comprising:

- “a MPEG-7 description scheme that includes the identification of the format of at least one of audio and visual media” at page 6/1, last paragraph;
- “said description scheme including data for rendering said at least one of said audio and visual media” at page 6/2, 2nd paragraph (i.e., “reproduction data”);
- “said at least one of said audio and visual media being contained within said description scheme” at page 6/2, 2nd paragraph. (Pereira teaches that “MPEG-7 descriptions may be physically co-located with the ‘reproduction data’, in the same data stream”)

Pereira does not explicitly teach: “said description scheme includes a choice of two different encoding scheme for data, namely, base16 and base64” as claimed. However, N3391 describes a MPEG-7 description scheme, which includes “choice of two different encoding scheme for data, namely base16 and base64” at page 11, section 6.2.4.7. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to employ the encoding scheme as taught in N3391 into Pereira’s description scheme because N3391 represents the International Standard for MPEG-7 description scheme. Using the encoding scheme as suggested by N3391 will ensure that the description scheme will be compliant with the standard, and therefore compatible with all applications implemented based on the standard.

As per claim 42, Pereira and N3391 teach the digital file of claim 41 discussed above. Pereira also teaches: “wherein said description scheme is InlineMedia”.

(The examiner relies on Applicant's specification for the definition of "InlineMedia", "that permits the identification of the format of the media stream" and "enables the description of audio and/or visual data located within the description itself, without having to refer to a location external to the description" (page 7, last paragraph). As discussed in the rejection of claim 41 above, Pereira teaches a similar description scheme and therefore anticipated the claimed element.)

As per claim 44, Pereira and N3391 teach the digital file of claim 43 as discussed above. N3391 also teaches: "said base16 is part of an element name MediaData16" at page 11, section 6.2.4.7.

As per claim 45, Pereira and N3391 teach the digital file of claim 43 as discussed above. N3391 also teaches: "said base64 is part of an element name MediaData64" at page 11, section 6.2.4.7.

As per claim 46, Pereira and N3391 teach the digital file of claim 41 discussed above. Pereira also teaches: "wherein said data is binary" at page 6/1, 2nd paragraph (i.e., "digital" format).

(10) Response to Argument

1. Rejection of claims 1-31, 33-42, and 44-59 under 35 U.S.C. §101.

Regarding the 35 U.S.C §101 rejection to claims 1-31, 33-42, 44-59, appellant argued that a digital file, on a computer readable storage medium, containing data organized so as to be capable of being visually rendered by a computer, is statutory subject matter. The examiner respectfully disagrees.

The claimed “digital file” is a digital image file encoded using JPEG2000 ISO standard. JPEG2000 is an improve version of JPEG image compression/encoding format, which is the standard format for image files produced by most digital cameras currently on the market. A typical JPEG file has the file extension *.JPG and is required an image viewer/editor such as “Window Picture and Fax viewer” or “PHOTOSHOP” to render and display image on a display screen. Clearly, digital photograph files are copyrightable, but not patentable.

Appellant argued that each independent claim includes the limitation of “a digital file, on a computer readable storage medium, containing data organized so as to be capable of being visually rendered by a computer” render each claim statutory because the data structure capable of functional interaction with a computer. The examiner respectfully submits that “data organized so as to be capable of being visually rendered by a computer” are clearly **nonfunctional** descriptive material. The “organized data” itself, even if stored on a computer readable medium, do not cause a computer to

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perform any function when inserted in to a computer, the data are only stored so as to **be read or outputted by a computer** without creating any functional interrelationship.

For example, a document stored on a floppy disk also contains "data organized so as to be capable of being visually rendered by a computer", and different document formats such as MS word or PDF provide different structures to organize the data. However, a stored document is apparently not patentable, so is a stored photo or image, because the data structure of the document or image is directed on nonfunctional descriptive material.

Common situations involving nonfunctional descriptive material are:

- A computer-readable storage medium that differs from the prior art solely with respect to nonfunctional descriptive material, such as music, photograph or literary work, encoded on the medium,
- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine function (i.e., the descriptive material does not reconfigure the computer), or
- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

MPEP chapter 2106, Patentable Subject Matter - Computer-Related Inventions provides:

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided.

Where certain types of descriptive material, such as music, literature, art, **photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship**, either as part of the stored data or as part of the computing processes performed by the computer, **then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer**. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).)

In conclusion, the claims are directed to a digital photograph file stored on a computer readable medium, which does not provide any functionality when inserted into a computer and requires a separate "suitable JPEG2000 viewer" (See Appellant's specification page 5) to render the image and process the information in the file . Claims **1-31, 33-42, 44-59** are therefore **nonstatutory** and the 101 rejection should be sustain.

**2. Rejection of claims 47-49 and 54 under 35 U.S.C 102(a) as being anticipated by
JPEG 2000**

Regarding claims 47-49 and 54, appellant argued that IT-JPEG 2000 does not teach “including information within said UUID box indicating the location of binary data, within said file and not within said UUID box, associated with said image”. On the contrary, IT-JPEG2000 teaches that UUID boxes can be used to store binary data, and UUID Info boxes, which act as index for the UUID’s in the file, contains a list of UUID’s and specifies links (i.e., “location”) to more information. UUID boxes and UUID Info boxes are distinct but within the JPEG2000 file. The examiner therefore mapped IT-JPEG2000’s “UUID Info boxes” to the claimed “UUID box”.

Appellant further argued that it is illogical to read the term “UUID box” on a “UUID Info box”. The examiner respectfully submits that there is no difference between “UUID box” or “UUID info box”, as long as they both have the same structure. The name/label of the box is nonfunctional descriptive material, which cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. **In re Ngai**, 367 F.3d 1336, 1339, 70 USPQ2d, 1864 (Fed. Cir. 2004). **CF. In re Gulack**, 703 F.2d 1381, 1385, 217 USPQ 401, 404, (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Further, appellant’s specification, page 2 lines 14-16 recites: “An actual file need not contain all of the boxes shown in FIG. 1, may contain different counts of the boxes, and/or **could use the boxes in different positions in the file**” which implies that the boxes are interchangeable.

3. Rejection of claims 41, 42, and 44-46 under 35 U.S.C 103(a) as being obvious over Pereira in view of MPEG-7.

Regarding claim 41-42 and 44-46, appellant argued that Pereira and MPEG-7 as combined, does not teach "said at least one of said audio and visual media being contained within said description scheme" because Pereira makes clear that the term "co-located" does not mean that the reproduction data is contained within the MPEG-7 description scheme. On the contrary, Pereira clearly teaches at page 6/2 that "MPEG-7 descriptions may be physically co-located within the 'reproduction data', **in the same data stream** or in the same storage system". Pereira teaches the data stream (i.e., MPEG-7 description scheme), which contain reproduction data (i.e., "audio and visual media") and therefore anticipates the claimed limitation.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Khanh B. Pham



Primary Examiner

Conferees:

Hosain Alam

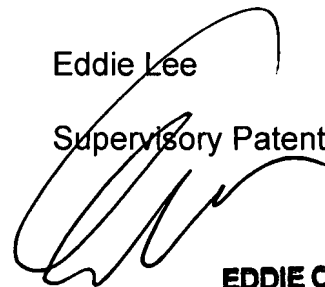


Supervisory Patent Examiner

AV 2166

Eddie Lee

Supervisory Patent Examiner



EDDIE C. LEE
SUPERVISORY PATENT EXAMINER